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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,282	04/04/2001	Katsuhiko Haji	S305-208US (NP082-1)	4404
570	7590	12/01/2003	EXAMINER TOOMER, CEPHIA D	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103-7013			ART UNIT 1714	PAPER NUMBER

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/826,282

Applicant(s)

HAJI ET AL.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13,15-18,20,21 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-27 is/are allowed.
- 6) ☒ Claim(s) 13,15-18,20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 25, 2003 has been entered.
2. This Office action is in response to the amendment filed August 25, 2003 in which claims 13, 17, and 24 were amended. It should be noted that claims 13, 15-18, 20-21 and 24-27 are pending. It is noted that claim 14 was canceled in a previous amendment; however, Applicant has not indicated the status of claim 14 in this present amendment.
3. The rejection of the claims under 35 U.S.C. 112, first paragraph is withdrawn in view of Applicant's arguments.
4. Claims 13, 15-18 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Campbell (US 4,527,996).

Campbell teaches a gasoline composition comprising a nitrogen-containing additive of the following formula  $H(OCHR'CHR'')_x(OCHR'''CHR^{iv})_yNR^vR^{vi}$  wherein  $R'$  and  $R''$  are independently H or an alkyl group of 1-4 carbon, at least one of  $R'$  and  $R''$  has at least 2 carbon atoms;  $R'''$  and  $R^{iv}$  are independently H or  $CH_3$ ,  $R^v$  and  $R^{vi}$  are independently H or  $(CH_2CH_2NH)_zH$  where  $z$  is 1-5 with the proviso that  $R^v$  and  $R^{vi}$  are

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not both hydrogen and z and y are independently integers from 1-30 (see abstract; col. 3, lines 1-20). Campbell anticipates the claims when in Campbell all parameters are as set forth with Z=1, and those parameters in the present invention are as follows: R<sup>1</sup> is H, R<sup>2</sup>-R<sup>5</sup> are H or C<sub>1</sub>-C<sub>16</sub> hydrocarbon, a is an integer from 1-20 and x is (B1) or (B4) wherein R<sup>15</sup> is C<sub>2</sub> alkylene, R<sup>16</sup> is H and R<sup>17</sup> is H.

Accordingly, Campbell teaching all the limitations of the claims, anticipates the claims.

5. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that Campbell does not anticipate the present claims because the compound exemplified in Campbell is different from that of the present claims.

It is well settled that a reference is relied upon for all that it teaches and is not limited to the preferred embodiments. The claimed nitrogen-containing compounds of the present invention are indeed anticipated by Campbell because the general formula of the nitrogen-containing compound of the present invention and the general formula of the hydroxy polyether polyamines of Campbell are within the same scope. When all parameters of Campbell are as set forth above and Z=1 and when the parameters of the present invention are as follows: R<sup>1</sup> is H, R<sup>2</sup>-R<sup>5</sup> are H or C<sub>1</sub>-C<sub>16</sub> hydrocarbon, a is an integer from 1-20 and X is (B1) or (B4) wherein R<sup>15</sup> is C<sub>2</sub> alkylene, R<sup>16</sup> is H and R<sup>17</sup> is H, the compounds are within the same scope.

6. Applicant's arguments and the 132 declaration submitted by Katsuhiko Hagi are sufficient to overcome the 103 rejection of the claims over Campbell. Therefore, claims 24-27 are allowable.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Cephia D. Toomer  
Primary Examiner  
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